

### REMARKS

The present application relates to inbred maize line PH581. Claims 2-57 have been canceled. New claims 58-87 have been added. No new matter has been added by the present amendment. Applicants respectfully request consideration of the following remarks.

#### Detailed Action

##### *A. Claim and Specification Objections*

Applicants acknowledge the rejections of 35 U.S.C. § 112, second paragraph; the rejection of claim 40 under 35 U.S.C. § 112, first paragraph; and the art rejection under 35 U.S.C. §102/103, as withdrawn.

The Examiner objects to the Table A comprising SSR data inserted on page 16 of the specification at line 23 under 35 U.S.C. § 132 as new matter. Applicants object to the Examiner's objection of new matter however in order to expedite prosecution Applicants herein cancel the above-referenced material that had been filed March 11, 2003, thus alleviating this rejection.

##### *B. Newly Submitted Claims*

Applicants acknowledge the addition of new claims 58 through 87, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification. Support for the specific items noted in the claims faxed by Examiner Fox can be found within the specification for *Bacillus thuringiensis* on page 28; for imidazolinone, sulfonylurea, glyphosate, glufosinate, L-phosphinothricin, triazine, and benzonitrile on pages 31-32; for phytase on page 32; for stearyl-ACP desaturase, fructosyltransferase, levansucrase, alpha-amylase, invertase and starch branching enzyme on pages 32-33; and for waxy starch and increased amylose starch on pages 21 and 33.

**Rejections Under 35 U.S.C. § 112, Second Paragraph**

Claims 51 and 55-57 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 51, 55, and dependents thereon, stand indefinite for improper Markush terminology. Although not acceding to the Examiner's rejection, in order to expedite prosecution Applicants have canceled claims 51, 55, and dependents thereon, thereby rendering this rejection moot.

In light of the above amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejections under 35 U.S.C. § 112, second paragraph.

**Rejections Under 35 U.S.C. § 112, First Paragraph**

Claims 43 and 50-53 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The Examiner states that claim 43 recites "at least 50% genetic contribution from" and claims 50 and 52 recite "backcross conversion" in which there is no basis in the specification for either term therefore constituting new matter.

Although not acceding to the Examiner's rejection, to expedite prosecution Applicants have canceled claims 43 and 50-53, thereby rendering this rejection moot. Applicants have added new claims 58-87, as specifically stated by the claims faxed by Examiner David Fox on November 15, 2002 and the new sample claim submitted by Supervisory Patent Examiner Amy Nelson via e-mail on August 7, 2003. The new claims do not add new matter as there is support for the claims in the originally filed specification as described *supra*.

Claims 9-10, 15-16, 28-29, 37-39, 41-43 remain rejected and claims 50-54 and 57 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record stated in the last Office Action on pages 3-5.

Applicants traverse this rejection. Nevertheless, in order to expedite prosecution claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54 and 57 have been canceled and new claims 58-87 have been added as disclosed *supra*. Applicants request reconsideration.

Claims 9-10, 15-16, 28-29, 37-39, 41-43 remain rejected and claims 50-54 and 57 stand rejected under 35 U.S.C. § 112, first paragraph as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains or with which it is most nearly connected, to make and/or use the invention, as stated on pages 6-8 of the last Office Action.

Applicants respectfully traverse this rejection. The Applicants have provided assurance that at least 2500 seeds of inbred maize line PH581 have been deposited with the ATCC. In view of this assurance, the rejection under 35 U.S.C. § 112, first paragraph, should be removed. (MPEP § 2411.02). Applicants submit in order to expedite prosecution claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54 and 57 have been canceled and new claims 58-87 have been added as disclosed *supra*. It is respectfully submitted that Applicants' claims are sufficiently described and enabled by the specification.

In light of the above amendments and remarks, Applicants respectfully request withdrawal of the rejections to claims 9-10, 15-16, 28-29, 37-39, 41-43, 50-54, and 57 under 35 U.S.C. § 112, first paragraph.

#### Summary

Applicants acknowledge that claims 1-2, 4-8, 21, 23-27, and 40 are allowed.

Applicants have amended the claims as suggested by Examiner David Fox and Supervisory Patent Examiner Amy Nelson as allowable. Applicants submit the claims place the application in condition for allowance and comply with all requirements of form set forth in previous office actions.

#### Conclusion

In conclusion, Applicants submit in light of the above amendments and remarks, the claims as amended are in a condition for allowance, and reconsideration is respectfully requested.

If it is felt that it would aid in prosecution, the Examiner is invited to contact the undersigned at the number indicated to discuss any outstanding issues.

No fees or extensions of time are believed to be due in connection with this amendment; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account No. 26-0084.

Reconsideration and allowance is respectfully requested.

Respectfully submitted,



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